

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

SON5180.84A

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on _____

Signature _____

Typed or printed name _____

Application Number

10/771,805

Filed

02/04/2004

First Named Inventor

Clay Fisher

Art Unit

2161

Examiner

Daye, Chelcie L.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/John P. O'Banion/

☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

John P. O'Banion

Typed or printed name

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Registration number 33201

916-498-1010

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☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

07/28/2011

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below.

☒ *Total of 1 forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/771,805 Confirmation No.: 3337
Applicant : CLAY FISHER
Title : METHODS AND APPARATUSES FOR SYNCHRONIZING AND
TRACKING CONTENT
Filed : 02/04/2004
TC/A.U. : 2161
Examiner : CHELCIE L. DAYE
Docket No. : SON5180.84A
Cust. No. : 36813

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF CONFERENCE ARGUMENTS

Dear Sir:

1. Considerations on Examination Process.

This application has been pending over seven years, and has been through five final office actions, and one appeal which resulted in prosecution being reopened by the Examiner. In each case the rejections were overcome, whereupon a new office action was generated that merely swapped out or added a new reference. The Applicant submits that this serial examination approach is not in keeping with a proper examination process and the timely advancement of the case.

2. Reference Teachings Misapplied.

In the latest Final Office Action, the Claims are rejected on the basis of a combination between Schleifer (U.S. Pat. No. 7,526,768), LaRue (U.S. Publ. No. 2002/0133508), and a new reference of Searby (U.S. Patent No. 5,412,402).

(1) The Schleifer and LaRue reference are relied upon for teaching the bulk of the material of the independent claims, in particular Claim 1. However, these references whether considered separately or in combination with one another and what is known in the art, DO NOT provide any proper basis for receiving new content for which no record exists and creating the content record as described in the independent claims.

The claims specifically recites that *"new content"* is *"content for which no record exists"*. They do not say *"for which no record exists on the device receiving the content"*. The references cited have all been directed toward passing a content record to a device that does not contain that content record. But clearly if a content record is being passed, ...then *ipso facto* EXISTS. The application abundantly describes, such as on page 14, lines 8-20, that a new content item is *"content without a record"* and that it is *"new content to the system"*.

Passing of content records, not *"new content for which no record exists"*, is what is described in these two cited references. Schleifer reference receives a record from another device and seeks to synchronize that record on the given device. The rejection admits that Schleifer lacks a proper teaching of new content and asserts a combination with LaRue to overcome these shortcomings. Yet the LaRue reference is directed to incorporating existing records of a dataset into a "Grand Unified Dataset" (GUD), as was described in the prior response. Therefore, LaRue is taking an existing record of a first database and adding the GUD identifier when this record is subsumed into the GUD; it is not therefore operating on new content for which no record exists.

(2) The latest reference is the Searby reference which is relied upon for teaching *"image content"* and an *"image analysis"*. The Searby reference is misapplied. This is not surprising since the Searby reference is directed to an apparatus for electronic painting, and clearly NOT to *"method of tracking and synchronizing content containing images across multiple devices, including a plurality of client devices and a server"* as recited in the instant claims.

The Searby reference, is also not combinable with the Schleifer and LaRue reference, as it is directed to different objects and operating principles and could not be applied without making the prior art unsuited for its purpose.

The rationale for asserting the combination with Searby is that *"On the other hand, Searby discloses the content being image content, and said comparing includes image analysis between the new content and the existing content (col.5, lines 39-45 and col. 4, lines 5-21, Searby)"*.

From a reading of these cited sections of Searby it can be readily seen that no comparable "*image analysis*" as recited in applicant claims is disclosed.

Col. 5, lines 39-45:

"Referring now to FIG. 1, an electronic graphic system, generally indicated at 1, comprises a bulk storage device 2 for storing data relating to at least one initial image processed, or to be processed, by the system under the control of a user, who it is envisaged will be an artist unfamiliar with the workings of computers and associated technologies."

Col. 4, lines 5-21:

"According to another aspect of the present invention there is provided a method of modifying data defining an image, the method comprising: creating control data representing a desired distribution of interpolation coefficients and storing said control data in a control store by way of a process in which existing control data in the control store is compared with new control data created in response to the manipulation of user operable input means and is replaced with the new data when a predetermined relationship is found between the new data and the existing data; selecting a colour; combining the image data with data representing the selected colour in accordance with the control data; displaying an image derived from the combined image and colour data; and updating the image data with the combined data once acceptable modifications have been effected to the displayed image."

The Applicant contends that the only aspect above which resembles "*analyzing the image content*" is the comparing of control data described in the preceding paragraph. Yet, this control data does not comprise an image. The control data is described as first being "*creating control data representing a desired distribution of interpolation coefficients*", and later in the paragraph as "*new control data created in response to the manipulation of user operable input means*", which will be remembered as input, such as the tablet inputs, to the electronic painting program of Searby.

In view of the above, it is seen that Searby does not teach what it is relied upon to teach, and is clearly misapplied.

(3) A combination is asserted with Searby without providing any description of the specific structures and elements of Searby that are asserted to be combined with Schleifer and LaRue. The teachings of Searby are considered as if they are a general

concept of both "*image content*" and "*image analysis*". On that basis, any application which could be said to utilize either "*image content*" or "*image analysis*" would be obvious in view of Searby, regardless of the structures used to carry these aspects out. It is noted that patents are granted on the basis of specific structures and steps and not on mere concepts.

The only rationale provided for the combination is that "*A skilled artisan would have been motivated to combine in order to provide a plurality of alternate content.*" The above does not appear to be "*a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references*", as required by MPEP 706.02k.

(4) The combination of references is misapplied as the Searby reference cannot be combined with the Schleifer and LaRue references.

As described in its abstract, Schleifer is directed to "*The present invention allows a user to synchronize a device with at least two data sources that may cross-pollinate. The user's device is used to shuttle changes between the sources and resolves conflicts when changes are made to an item on multiple sources concurrently.*"

In a similar manner, the LaRue reference is entitled "*system and methods for synchronizing datasets using cooperation among multiple synchronization engines*", and describes some elements of synchronization regarding incorporating existing records of a dataset into a "*Grand Unified Dataset*" (GUD). These references still have significant distinctions as was described in prior Office Action responses.

However, the Searby reference is directed to "*electronic graphic systems*", which are "*for use in the painting of an image*" as seen in the abstract. The first portion of the background of Searby recites "*In electronic graphic systems the painting or drawing of an image can be simulated by electronic means.*"

One can clearly see in FIG. 1 of this application the drawing tablet 7, means for registering address inputs 8, stylus pressure 9, brush shape 10, brush coefficients 12, which are directed to a combiner 4 and stored 2, 3 or viewed 5.

The objects of the Searby reference are seen in the first three paragraphs of its summary of the invention as follows.

"The present invention resides in the realization that greater flexibility can be achieved by separating data representing drawings made by a user from data representing an original image until such time as a satisfactory result has been observed in a preview derived from the separate data.

The present invention also resides in the realization that by providing two separate stores, one containing an initial image to be modified and the other containing control data representing user defined modifications to be made to the initial image, painting can be made highly flexible with the user being able to observe modifications before they are committed to the initial image.

The present invention provides a flexible means by which a simple line drawing algorithm for example a binary line drawing algorithm (as defined hereinabove) can be used to paint into a colour image."

It is apparent from the above brief summary that the new Searby reference is thus directed to different objects and operating principles than the Schleifer and LaRue references, whereby a combination therewith would render these devices unsatisfactory for their intended purpose in contradiction with MPEP 2143.01.

3. Conclusion.

The misapplication of reference teachings are not merely interpretive, but illustrate clear error as shown above from the Searby teachings themselves. The burden in providing a *prima facie* case has not been met. A pre-appeal review is respectfully requested.

Date: July 28, 2011

Respectfully submitted,

/John P. O'Banion/

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